



# UNITED STATES PATENT AND TRADEMARK OFFICE

MLW

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,767	09/01/2000	Scott T. Allan	A-68678/MAK/LM	6140

7590

02/13/2004

Flehr Hohbach Test Albritton & Herbert LLP  
Suite 3400  
Four Embarcadero Center  
San Francisco, CA 94111-4187

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/653,767

Applicant(s)

ALLAN ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 26-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 7.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of species (a) Claims 15 and 67 by Applicant's Attorney Jennifer Lane on 2/4/2004 (telephonic examiner interview - paper No.6) is acknowledged.
2. Claims 1-15 and 26-73 will be examined as one distinct species of invention.

### *Response to Amendment*

3. The cancellation of Claim 67 is withdrawn. Claims 1-73 are currently pending in application 09/653,767.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 60-64 are rejected under 35 U.S.C. 102(a) as being anticipated by Franklin et al. (WO 01/41033 A2).
6. As per independent Claim 60, Franklin discloses a method for displaying advertisements ("ads") at a point-of-sale (POS) location, the method comprising: receiving a first ad for display with out regard to whether a transaction meets predetermined criteria (scheduled

advertisements); then engaging in a consumer transaction; during the transaction, receiving a second ad for display when the transaction meets predetermined criteria (triggered advertisements) (pg9 L3-20, pg12 L16-25).

7. As per Claim 61, Franklin discloses wherein the steps of receiving the first ad for display comprises receiving, at a predetermined interval, ads for display without regard to whether a transaction meets predetermined criteria during the transaction.
8. As per Claim 62, Franklin discloses during the transaction, displaying the first ad.
9. As per Claim 63, Franklin discloses during the transaction, displaying the second ad.
10. As per Claim 64, Franklin discloses during the transaction, displaying the first and second ads.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-15, 26-66, and 68-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (WO 01/41033 A2).**

13. As per independent Claims 1 and 68, Franklin discloses a method for displaying advertisements (“ads”) at a point-of-sale (POS) location, the method (computer-readable

medium) comprising: determining an advertisement for display and displaying the ad (abstract, pg4 L3-22, Claim1).

14. Franklin fails to expressly disclose dividing a consumer transaction at a POS location into multiple time frames and determining/displaying an add in said time frame.
15. However, Franklin does disclose displaying a default advertisement before a transaction and displaying a customer specific advertisement once a transaction begins, based on customer card data or the products being purchased (abstract, pg9 L3-20, pg12 L16-25).
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included dividing a consumer transaction at a POS location into multiple time frames and determining/displaying an add in said time frame in the system disclosed by Franklin, for the advantage of providing a method for displaying advertisements (“ads”) at a point-of-sale (POS) location, with the ability to increase customer response/attentiveness by displaying a relevant advertisement as the transaction progresses.
17. As per Claim 2, Franklin discloses wherein the step of dividing a transaction into time frames comprises dividing the transaction into time frames, each of the time frames substantially spanning an activity performed during a transaction.
18. As per Claims 3 and 69, Franklin discloses wherein the step of dividing a transaction into time frames comprises dividing the transaction into time frames, one of the time frames spanning one of the following transaction activities: waiting for a consumer to begin a transaction; greeting a consumer; beginning a transaction; selecting a form of payment; swiping a card for a form of payment; entering a security code for the form of payment;

identifying a product for purchase; displaying a total cost for products identified for purchase; signing for a transaction; and thanking a consumer (for) his purchase.

19. As per Claim 4, Franklin discloses wherein the step of dividing a transaction into time frames comprises dividing the transaction into time frames, each of the time frames spanning one of the following activities: waiting for a consumer to begin a transaction; greeting a consumer; beginning a transaction; selecting a form of payment; swiping a card for a form of payment; entering a security code for the form of payment; identifying a product for purchase; displaying a total cost for products identified for purchase; signing for a transaction; thanking a consumer (for) his purchase; surveying a consumer; promoting an event; applying for a credit card; informing a consumer; identifying a consumer; interacting with a consumer; and passing through an interstitial period.
20. As per Claim 5, Franklin discloses wherein the step of dividing a transaction into time frames comprises dividing a consumer-product transaction into time frames.
21. As per Claims 6-8, Franklin discloses wherein the step of dividing a transaction into time frames comprises dividing a bricks-and-mortar consumer-product transaction, e-commerce consumer-product transaction, or a consumer-service transaction, into time frames.
22. As per Claim 9, Franklin discloses wherein the step of determining an ad display in one of the time frames comprises transmitting information about the transaction from the POS location to an ad-management service; determining on the ad-management service and based on the information, an ad for display; and receiving a response indicating the determined ad.
23. As per Claim 10, Franklin discloses wherein the step of transmitting comprises broadcasting information to multiple ad-management services.

24. As per Claim 11, Franklin discloses wherein the step of determining an ad comprises determining an ad, having an identifier; and the step of receiving an indicative response comprises receiving the identifier for the determined ad and not the ad itself.
25. As per Claim 12, Franklin discloses caching the indicative response.
26. As per Claim 13, Franklin discloses caching the indicative response and a targeting filter for the response; and subsequently applying the targeting filter to determine whether the ad indicated by the response is still appropriate for display.
27. As per Claim 14, Franklin discloses wherein the step of determining an ad for display comprises prioritizing multiple ads competing for display, producing an ad with highest priority; determining the ad with highest priority as the ad for display.
28. As per Claim 15, Franklin discloses wherein the step of prioritizing multiple competing ads comprises setting the priority of an ad for display when the transaction meets predetermined criteria (a “specific ad”) higher than the priority of an ad for display when no specific ad is available.
29. As per Claim 26, Franklin discloses displaying the determined ad; determining the next highest-priority ad, if any, as the ad for display.
30. As per Claim 27, Franklin discloses wherein the step of determining further comprises overriding the determination of the highest-priority ad as the ad for display.
31. As per Claim 28, Franklin discloses wherein the step of determining further comprises overriding the determination of the highest-priority ad as the ad for display at most once per transaction.

32. As per Claim 29, Franklin discloses wherein the step of determining an ad for display comprises reserving one of the time frames for ads for display without regard to transaction criteria; and when the one time frame is the reserved time frame, excluding all ads for display when the transaction meets predetermined criteria.
33. As per Claim 30, Franklin discloses wherein the step of determining an ad for display comprises reserving all of the time frames for ads from a predetermined set of sponsors, the set having a size of one or more.
34. As per Claim 31, Franklin discloses nonetheless determining an ad to display when the transaction meets predetermined criteria as the ad for display and preempting a reserved time frame with the determined ad.
35. As per Claim 32, Franklin discloses wherein the step of displaying the ad comprises displaying the ad in the one time frame.
36. As per Claim 33, Franklin discloses wherein the step of displaying the ad comprises displaying the ad in a time frame following the one time frame.
37. As per Claim 34, Franklin discloses setting a minimum duration for the determined ad; and the step of displaying the advertisement comprises displaying the ad for that minimum duration.
38. As per Claim 35, Franklin discloses setting a system-wide minimum ad duration; and setting a minimum ad duration for the ad, the minimum ad duration a natural-number multiple of that system-wide minimum ad duration; and the step of displaying the advertisement comprises displaying the ad for that minimum ad duration.



39. As per Claim 36, Franklin discloses wherein the step of displaying the advertisement comprises displaying the beginning of the ad but not the end of the ad.
40. As per Claim 37, Franklin discloses wherein the step of displaying the advertisement comprises displaying the beginning of the ad but not its end due to an action of a consumer.
41. As per Claim 38, Franklin discloses setting a minimum duration for the determined ad; and the step of displaying the advertisement comprises displaying the ad longer than that minimum duration due to an action of a consumer.
42. As per Claim 39, Franklin discloses wherein the step of displaying comprises displaying the determined ad and another ad in the one time frame.
43. As per Claim 40, Franklin discloses wherein the step of displaying comprises displaying in the one time frame the determined ad, having a first sponsor, and the other ad, having a sponsor different from the first sponsor.
44. As per Claim 41, Franklin discloses responding to the ad.
45. As per Claim 42, Franklin discloses wherein the step of responding to the ad comprises indicating one of consent and lack of consent to a proposition of the ad.
46. As per Claim 43, Franklin discloses wherein the step of responding to the ad comprises indicating one of consent and lack of consent to a proposition of the ad by activating an input device at the POS location.
47. As per Claim 44, Franklin discloses recording a representation of the response.
48. As per Claim 45, Franklin discloses communicating a representation of the response to a computer system for collecting responses.
49. As per Claim 46, Franklin discloses repeating the steps of determining and displaying an ad.

50. As per Claim 47, Franklin discloses advancing from the one time frame into another time frame; and repeating the steps of determining and displaying an ad with the other time frame.
51. As per Claim 48, Franklin discloses wherein the step of advancing comprises activating an input device at the POS location; and in response, advancing from the one time frame into the other time frame.
52. As per Claim 49, Franklin discloses wherein the step of advancing comprises commanding from a POS system advancement from the one frame; and in response, advancing from the one time frame into the other time frame.
53. As per Claim 50, Franklin discloses wherein the step of advancing comprises recognizing that activity that the one frame spans has ended; and in response, advancing from the one time frame into the other time frame.
54. As per Claim 51, Franklin discloses wherein the step of advancing comprises recognizing that a timeout has occurred; and in response, advancing from the one time frame into the other time frame.
55. As per Claim 52, Franklin discloses repeating the steps of determining and displaying an ad with successive ones of the multiple time frames until the transaction completes.
56. As per Claim 53, Franklin discloses repeating the method from the step of dividing with a subsequent transaction.
57. As per Claim 54, Franklin discloses repeating the steps of determining and displaying an ad with successive ones of the multiple time frames until a following transaction begins.

58. As per Claim 55, Franklin discloses where the displayed ad was an ad for display when the transaction met predetermined criteria, disqualifying that ad from displaying again in the transaction.
59. As per Claim 56, Franklin discloses where the displayed ad was an ad that is for display without regard to the specifics of the transaction and that originated in an ad-management service, disqualifying that ad from displaying again in the transaction.
60. As per Claim 57, Franklin discloses receiving a first ad for display without regard to whether a transaction meets predetermined criteria.
61. As per Claim 58, Franklin discloses wherein the step of receiving the first ad is performed before the step of dividing the transaction.
62. As per Claim 59, Franklin discloses wherein the step of receiving the first ad comprises receiving, at a predetermined interval, ads for display without regard to whether a transaction meets predetermined criteria during the transaction.
63. As per Claim 70, Franklin discloses a POS system displaying advertisement ("ads") comprising: the computer-readable medium of claim 68; a CPU for executing the program in the medium; a bus, communicatively coupling the medium and the CPU; and a display, responsive to commands from the CPU.
64. As per independent Claims 65 and 71, Franklin discloses a method (computer-readable medium) for displaying advertisements ("ads") for presentation to multiple consumers at respective POS locations, the method comprising: substantially simultaneously receiving first and second requests for ads for display when a transaction meets predetermined criteria, each

request transmitting respective information about respective consumer transactions occurring at respective POS locations (pg7 L14-24, pg15 L20-25, pg16 L1-7, Claims 16-19).

65. Franklin fails to expressly disclose determining from the transmitted information that the first and second transactions are similar enough that one ad will satisfy both requests; responding to both requests with the same response indicating one ad.
66. However, Franklin does disclose displaying POS advertising to multiple transaction lanes, and upon receiving a predetermined criteria (time of day, purchased product, customer card) providing an advertisement which correlates with the predetermined criteria (pg15 L20-25, pg16 L1-7, Claims 16-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to simply apply a correlation/priority filter to both requests for advertising if only one POS screen was available for multiple POS locations. However, the prior art seems to disclose an improvement to the instant invention – by providing a multiple amount of POS screens. Furthermore, the specification fails to provide information as to why such an element would be beneficial to the system users.
67. As per Claim 66, Franklin discloses transmitting a request for the one ad to multiple ad-management services.
68. As per Claim 72, Franklin discloses a CPU for executing the program in the medium; a bus, communicatively coupling the medium ad the CPU
69. As per Claim 73, Franklin discloses first and second links respectively and communicatively coupling the first and second instances of the POS system to the advertising-management service.

70. **Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin in view of Kolls (US 6,615,183)**

71. As per independent Claim 67, Franklin discloses a method for displaying advertisements (“ads”) at a point-of-sale (POS) location, the method comprising: transmitting information about a transaction to an ad-management service; determining on the ad-management service, based on the information, an ad for display; receiving a response indicating the service, based on the information, an ad for display (Claim 1); receiving a response indicating the service-determined ad; prioritizing any ads competing for display, producing an ad with highest priority, by setting the priority of an ad for display when the transaction meets predetermined criteria (a “specific ad”) higher than the priority of an ad for display when no specific ad is available; determining the ad with highest priority as the ad for display (pg9 L3-20); displaying the determined ad in one of (1) a one time frame and (2) a frame following the one time frame from its beginning but not through its end due to an action of a consumer but other wise from its beginning through its end (pg9 L3-20); and repeating the steps of determining and displaying an ad with successive ones of the multiple time frames until the transaction completes (Claim 31).

72. Franklin fails to expressly disclose dividing a transaction into, each of the time frames spanning one of the following activities: waiting for a consumer to begin a transaction; greeting a consumer; beginning a transaction; selecting a form of payment; swiping a card for a form of payment; entering a security code for the form of payment; identifying a product for purchase; displaying a total cost for products identified for purchase; signing for a transaction; thanking a consumer (for) his purchase; surveying a consumer; promoting an

event; applying for a credit card; informing a consumer; identifying a consumer; interacting with a consumer; and passing through an interstitial period.

73. However, Franklin does disclose displaying a default advertisement before a transaction and displaying a customer specific advertisement once a transaction begins, based on customer card data or the products being purchased (abstract, pg9 L3-20, pg12 L16-25).

74. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included dividing a transaction into, each of the time frames spanning one of the following activities: waiting for a consumer to begin a transaction; greeting a consumer; beginning a transaction; selecting a form of payment; swiping a card for a form of payment; entering a security code for the form of payment; identifying a product for purchase; displaying a total cost for products identified for purchase; signing for a transaction; thanking a consumer (for) his purchase; surveying a consumer; promoting an event; applying for a credit card; informing a consumer; identifying a consumer; interacting with a consumer; and passing through an interstitial period, in the system disclosed by Franklin, for the advantage of providing a method for displaying advertisements (“ads”) at a point-of-sale (POS) location, with the ability to increase customer response/attentiveness by displaying a relevant advertisement as the transaction progresses.

75. Franklin also fails to expressly disclose recording a representation of any response to the ad.

76. However, Kolls discloses recording a representation of any response to a POS ad (Claim 1).

77. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included recording a representation of any response to the ad as discloses by Kolls, in the system disclosed by Franklin, for the advantage of providing a

method for displaying advertisements (“ads”) at a point-of-sale (POS) location, with the ability to increase customer service by tracking customer interactions with the POS advertising and developing marketing plans with the tracked information.

***Conclusion***

78. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.
79. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**“Turning POS Terminals Into Retail Marketing Machines,” Debit Card News, v1, n4, p1+, August 3, 1995.**

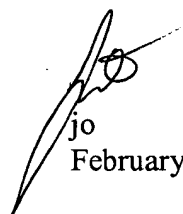
Debit Card News discloses several POS Terminal systems used to provide advertising to customers during a commercial transaction.

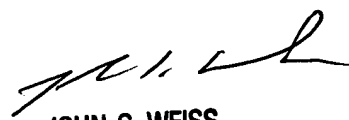
80. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
81. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
82. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization

Art Unit: 3629

where this application or proceeding is assigned (703) 872-9306 for all official communications.

83. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
jo  
February 11, 2004

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600